

Appl. No. 09/954,772
Atty. Docket No. 6009RXD
Reply Dated February 4, 2004
Reply to Office Action of July 8, 2003
Customer No. 27752

REMARKS

Claims 124 and 125 are pending.

Claims 1-123 and 126-145 have been canceled.

Rejection Under 35 USC 103(a) Over Katznellenbogen et al., Martin et al., Eliel et al., and Green et al.

The Office Action rejects Claims 124 and 125 under 35 U.S.C. section 103(a) as being unpatentable over Katznellenbogen et al., Martin et al., Eliel et al., and Green et al.

Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met per MPEP §2142 and *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. All three criteria must be met to establish a *prima facie* case of obviousness. Applicants submit the Office Action fails to meet any one of these three requirements.

Applicants submit the Office Action misapplies the criterion for obviousness by asserting, “[T]he criterion for obviousness is *not whether the references motivate the preparation of these diols*; it is whether the person of ordinary skill would believe that the presently claimed diols have the same or similar properties as those of the prior art.” Rather, Applicants point out that in fact the prior art must provide a basis for the modification. Motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.”); accord *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) (“[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification”) (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Applicants submit

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the Office Action fails to make a *prima facie* showing of obviousness by misapplying a proper obviousness analysis.

Applicants submit this burden applies equally in the context of isomers. The Office Action implicitly maintains its position from an earlier Office Action asserting that since the claimed 7-carbon diols are allegedly simple structural isomers of 7-carbon diols disclosed in the art, they would be expected to have similar physical properties to those which are disclosed in the art. Applicants submit that as a general matter, **isomerism by itself** should not raise a *prima facie* case of obviousness. *Ex parte Mowry*, 91 U.S.P.Q. 219, 221 (Bd. Pat. App. 1950) (rejecting the proposition that isomers in the broad sense are necessarily equivalent and holding claimed cyclohexylstrene unobvious over prior art isohexylstyrene). Indeed, the Federal Circuit has admonished against generalizing, especially in the area of chemical structural obviousness, requiring proof in the prior art to support a proposed structural change. See *In re Grabiak*, 769 F.2d 729, 731-32, 226 U.S.P.Q. 870, 872 (Fed. Cir. 1985) (finding no *prima facie* obviousness where the prior art did not suggest appellants' substitution of a thioester for an ester substituent on a carboxamide compound). In view of this legal backdrop, Applicants submit that the Office Action by merely alleging **isomerism by itself** fails to establish a *prima facie* showing of obviousness.

Moreover, Applicants submit the Office Action fails to establish a reasonable expectation of success. Beyond looking to the prior art to determine if it suggests doing what the inventor has done, the Office must also consider if the art provides the required expectation of succeeding in that endeavor. See *In re Dow Chem. Co.*, 837 F2d at 473, 5 U.S.P.Q.2d at 1531 ("Both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure.") "Obviousness does not require *absolute* predictability, but a reasonable expectation of success is necessary." *In re Clinton*, 527 F.2d 1226, 1228, 188 U.S.P.Q. 365, 367 (C.C.P.A. 1976). Applicants submit no such analysis was conducted.

Lastly, Applicants respectfully remind the Office that the duty to establish a *prima facie* case of obviousness rests on the Office. Shifting the burden to the Applicant ("[Obviousness] may be rebutted by applicant by preparing and comparing the diols of the prior art with those presently claimed"), is improper before a *prima facie* showing is made.

In view of the foregoing, Applicants request the withdrawal of the obviousness rejection.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC 103. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 124 and 125.

Respectfully submitted,
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